

REMARKS

Applicants greatly appreciate the thoughtful consideration shown their undersigned representative and patent counsel for assignee in an interview on 25 June 2003. The willingness of the Examiner to explain her position and to consider the positions voiced by representatives of the assignee is much appreciated.

Claims 48, 50-52 are currently pending. Claims 51-52 are cancelled, claim 48 is amended and claim 53 is added herein. Accordingly claims 48, 50 and 53 are now pending. No new matter is added by these amendments. For example, support for new claim 53 can be found, e.g., at page 54, line 3 through page 55, line 12; page 55, lines 19-22; page 79 line 33 through page 80, line 3; page 82, lines 16-20; and Example 31 at page 124, and Example 46 at page 141 of the Application as-filed.

The history of the restriction/prosecution activity in this matter is as follows:

- On 17 December 2002 the Office issued its first Restriction in the present matter.

Eight Groups were provided in this Restriction.

- In response, on 18 February 2003, the Applicants traversed the requirement, elected a specific Group, canceled claim 49, and introduced claims 50 and 52. Particular reasoning for the traversal was included in this response.

- An interview took place on 4 March 2003, on the subject of the 18 February 2003 Restriction and the Applicant's response.

- On 5 May 2003, the Office issued a second Restriction Requirement comprising the current 19 Groups.

- The Office again granted an interview to discuss the current restriction on 25 June 2003. As indicated during the interview, the Office would recombine several of the currently pending Groups as encompassing subject matter that is not separately restrictable, without further action on the part of the Applicants. These Groups include the recombination of Groups II and III, the recombination of Groups V and VI, the recombination of Groups VIII and IX, the recombination of Groups XII and XIII, the recombination of Groups XIV and XV, and the

recombination of Groups XVI and XVII. The Applicants appreciate and respectfully acknowledge this recombination.

In the 5 May 2003 action, although the Office acknowledged the previous election by the Applicants, the previous Restriction and election was not made Final. Therefore, Applicants submit for the record that it is their understanding, based in-part on discussions during the 25 June 2003 interview, that the 5 May 2003 Restriction supercedes both the 17 December 2002 Restriction and the Applicants response of 18 February 2003. Thus, the 17 December 2002 Restriction and the 18 February 2003 election by the Applicants has no current or future effect on the scope of the examined subject matter in the present application. That scope will be determined in view of the present consolidated Restriction, Applicants' election and the Office response thereto.

The Applicants herein cancel dependent claims 51 and 52 which appear to have formed the basis of the present Restriction by the Office, as each of the Groups in the 5 May 2003 Restriction was representative of a property provided in canceled claims 51 and 52. Thus, on this basis, and others as addressed below, Applicants submit that the restriction is traversed and/or rendered moot and should be withdrawn.

Nevertheless, the Office requires the Applicants to elect a Group for further prosecution. In this regard, the Applicants elect Groups XV, with traverse. As discussed above and during the 25 June 2003 interview, the subject matter of Group XV is to be recombined with Group XIV. Thus, in the present election, the Applicants elect the subject matter of combined Groups XV and XIV, with traverse.

Applicants further note that these traversed yet elected groups XIV and XV are better characterized as being directed to protein-protein associations; this subject matter is supported by the application as-filed, such support is set forth in regarding added claim 53. Moreover, claim 53 reflects just such subject matter. Applicants note that as these claim groups were not delineated as set forth in this paragraph, this would constitute an example of claimed subject

matter being defined by the Office rather than the Applicants; traversal on this basis is addressed below.

The Applicants respectfully traverse on the following grounds:

(1) the manner/modality in which the function, production or status of 101P3A11 protein is evaluated is not dispositive of the invention as set forth in the specification and claims. Of particular importance, independent claim 48 is not limited as to the modality by which expression status is observed nor a particular expression status parameter;

(2) the fact that four claims are broken into 19 (or 13) groups is inconsistent with Applicants' right to define their invention, the invention is instead being defined by the Office with omission of desired subject matter;

(3) the subject matter of dependent claims 51-52 (presently cancelled) is not separately restrictable and, at most, a species election might be appropriate in light of generic/linking claim 48; and

(4) no undue search burden is present.

Applicants respectfully direct the Office's attention to the response of 18 February 2003 for the basis underlying each of these grounds as they were presented previously.

Accordingly, in light of the foregoing, Applicants respectfully request examination of the present claims on their merits.

Applicants expressly reserve their right under 35 U.S.C. § 121 to file a divisional application directed to the nonelected subject matter during the pendency of this application, or an application claiming priority from this application.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Assistant Commissioner to

charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket No. 511582002420.

Respectfully submitted,

Dated: July 22, 2003

By: 

David L. Devernove
Registration No. 50,128

Morrison & Foerster LLP
3811 Valley Centre Drive
Suite 500
San Diego, California 92130-2332
Telephone: (858) 720-7943
Facsimile: (858) 720-5125